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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/491,841 08/23/99 DALIME

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EXAMINER

SHLESINGER ARKWRIGHT & GARVEY LLP  
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LUEBKE, R

ART UNIT  PAPER NUMBER

2833

**DATE MAILED:** 07/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. <b>09/491,841</b>	Applicant(s) <b>Daume</b>
	Examiner <b>Renee S. Luebke</b>	Art Unit <b>2833</b>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1)  Responsive to communication(s) filed on Jun 4, 2001.
- 2a)  This action is FINAL.      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

#### Disposition of Claims

- 4)  Claim(s) 1-3, 6-9, 11-34, 39, and 40 is/are pending in the application.
- 4a) Of the above, claim(s) 2, 6, 9, 12, 15, 19, 21, 27, 28, 31-34, and 40 is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1, 3, 7, 8, 11, 13, 14, 16-18, 20, 22-26, 29, 30, and 39 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claims 2, 6, 9, 12, 15, 19, 21, 27, 28, 31-34, and 40 are subject to restriction and/or election requirement.

#### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved.
- 12)  The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- 15)  Notice of References Cited (PTO-892)      18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16)  Notice of Draftsperson's Patent Drawing Review (PTO-948)      19)  Notice of Informal Patent Application (PTO-152)
- 17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_      20)  Other: \_\_\_\_\_

1. This application contains claims 2, 6, 9, 12, 15, 19, 21, 27, 28, 31-34 and 40 drawn to an invention nonelected without traverse in Paper No. 10 of August 18, 2000. A complete reply to this final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

It is noted that amended claim 1 is no longer seen to be generic. Further, due to the amendments to claim 1, some of the withdrawn claims may be contradictory.

2. The information disclosure statement filed February 11, 2000 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language (those through which a line has been drawn). It has been placed in the application file, but the information referred to therein has not been considered.

Applicant argues that the references not in the English language are found on the search reports filed with the IDS. However, it is noted that there were no search reports provided with the IDS. There were, however, two search reports listed as prior art on the IDS. These papers were, themselves, not in the English language and were not considered. It is further noted that there is no apparent connection between these search reports and the present application.

3. Applicant is reminded of the proper language and format for an abstract of the disclosure. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure

concerns," "The disclosure defined by this invention," "The disclosure describes," etc. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

4. The disclosure remains objected to because of the following informalities:

- ✓ a. the phrase "illustratively substantially cylindrical" is unclear; to what does "illustratively" refer?
  - ✓ b. the specification should not refer specifically to claims (page 3), which may change,
  - ✓ c. reference numeral 92 (page 18, line 13) is not found in the figures under discussion,
  - ✓ d. the sentence beginning on line 22 of page 18 is unclear,
  - ✓ e. the phrase "radially recoiling" (page 19, line 24) is not understood in this context, and
  - ✓ f. the phrase "circular salient" (page 20, line 17) is not understood.
- ✓ Applicant is requested to correct the generally non-idiomatic language and improper grammar throughout the application.

In addition, the nature of base structure 4 is unclear. Initially (page 17 and Fig. 1) base 4 is described as a metal element. Later, however, (page 18 and Fig. 2) the outer surface of the base is stated to be an elastic material and appears to be an insulator.

Appropriate corrections are required.

5. Claims 8, 20, 22-24 and 39 objected to because of the following informalities:
- a. The spelling of "plate" should be corrected in claim 8.
  - b. Claims 20, 22, 23 and 39 are grammatically incorrect and appear to be missing text.

c. On line 2 of claim 24, it appears that a comma should be inserted after "part" (first occurrence).

d. On the last line of claim 39, it appears that "in assembly position" should be changed to -in assembled position-, or something similar, as the description refers to the device as assembled.

Appropriate corrections are required.

6. Claims 8 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Contrary to claim 8, the base cannot be a "plat(e)-shaped contact element." A plate shape does not have an interior and an exterior side as required of the base in the claim.

Regarding claim 26 the phrase "in particular" renders the claim indefinite because it is unclear whether the limitation following the phrase is part of the claimed invention.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 1, 3, 7, 8, 16-18, 22-25, 29, and 39 remain rejected under 35 U.S.C. 102(b) as being anticipated by Cauderay, et al. (EPO 0 744 788 A1). This device (see Figs. 6 and 7) comprises a base structure 10, sealing lips 11, 12, and a band shaped, electrically conducting contact element 4 including a contact protrusion 9. Applicant argues that the contact protrusion is not integral. However, portions that are glued or welded (which, as stated by applicant is the case in the Cauderay device) form a single part, or are integral. In regard to claims 3 and 8, as shown in Fig. 6, the band-shaped contact protrusion is metallic. Since the base structure is shown in an open position in Fig. 6 and is required to have a smaller radius to fit the base, it is inherently flexible as required by claim 7. In regard to claims 24 and 25, the base structure 10 is required to flex and then opens again to the position in Fig. 6 and is therefore seen to be elastic; further, it coats the outer side of the contact element 9.

10. Claims 11, 13, 14, 20, and 30 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Cauderay in view of Tinnerman '627. The contact protrusion of Cauderay is not elastic, etc. However, Tinnerman teaches the use of a contact element 10 comprising elastic projections 18 that better contact the base 21. This arrangement achieves better electrical contact on an encircling member that is intended to contact a cylindrical member. For this reason, it would have been obvious to use the contact element of Tinnerman in place of the contact element 9 of Cauderay. In regard to claim 30, Cauderay is silent about how the screws are held to the bracket. However, Tinnerman teaches the use of a threaded bracket thereby reducing the number of required parts. Therefore, it would have been obvious to use a threaded hole on the bracket or Cauderay as taught by Tinnerman.

11. Claim 26 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Cauderay. The material of the part 10 is not clear. However, it would have been obvious to form it of a thermoplastic material in view of the large number of electrical devices that use thermoplastic materials where conductivity is not required.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. It is suggested that responses to this final action be faxed to:

(703) 308-7722, 308-7724 or 308-7382

This facsimile transmission service for formal amendments is provided as part of Technology Center 2800's After Final program to improve communication with our customers. Use of this program reduces processing time, will result in more timely responses by the Office and should result in fewer requests for extensions of time. Please refrain from sending a confirmation copy, as noted in 37 CFR 1.6(d) and 1.8(b).

For formal communications, please mark "EXPEDITED PROCEDURE"

For informal or draft communications please clearly label "PROPOSED" or "DRAFT"

Alternatively, responses may be mailed to:

Box AF  
Assistant Commissioner for Patents  
Washington, DC 20231

**Hand-delivered responses should be brought to:**  
Crystal Plaza 4, Fourth Floor (Receptionist)  
2201 South Clark Place, Arlington, Virginia.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mrs. Renee Luebke at (703) 308-1511. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mrs. Paula Bradley, can be reached at (703) 308-2319.



Renee S. Luebke  
Primary Patent Examiner  
July 19, 2001